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IN THE
Supreme Court of the United States
OCTOBER TERM, 1995

SGS-THOMSON MICROELECTRONICS, INC.,
Cross-Petitioner,

v.

INTERNATIONAL RECTIFIER CORPORATION,
Cross-Respondent.

Cross-Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

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CROSS-PETITION FOR A WRIT OF CERTIORARI

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August 23, 1995

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QUESTION PRESENTED

Whether a party that seeks a declaratory judgment of patent unenforceability based upon the patentee's alleged fraud on the patent office has a right to a trial by jury under the Seventh Amendment.

LIST OF PARTIES AND AFFILIATES

In addition to the parties listed in the caption, SGS-Thomson Microelectronics, S.r.l. (an Italian company) was a defendant in the district court; it was not a party in the court of appeals.

Pursuant to S. Ct. Rule 29.1, the following are the parent companies and non-wholly owned subsidiaries of SGS-Thomson Microelectronics, Inc.:

SGS-Thomson Microelectronics, N.V.
Thorn EMI plc
Thomson-CSF.

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CROSS-PETITION FOR A WRIT OF CERTIORARI

SGS-Thomson Microelectronics, Inc. ("ST"), hereby submits this cross-petition for a writ of certiorari to the United States Court of Appeals for the Federal Circuit. This cross-petition is conditional upon the grant of the petition for a writ of certiorari filed by International Rectifier Corporation ("IR") on July 24, 1995, No. 95-143.

IR's petition in No. 95-143 presents two questions: (1) whether a party seeking a declaratory judgment of patent invalidity on the ground that the invention was not patentable under the patent laws has a right to trial by jury under the Seventh Amendment; and (2) whether a party seeking a declaratory judgment of noninfringe-

ment of a patent has a right to trial by jury under the Seventh Amendment. The United States Court of Appeals for the Federal Circuit in the decision below held that there was a right to trial by jury on such claims.

This cross-petition presents a related question: whether a party that seeks a declaratory judgment of patent unenforceability on the ground that the patentee committed fraud on the patent office has a right to try that claim to a jury under the Seventh Amendment. The court of appeals held that there was no right to trial by jury on that claim.

DECISIONS BELOW

The opinions of the district court and of the court of appeals are listed in the petition and opposition in No. 95-143. The opinions are reproduced in the appendices to those documents.

STATEMENT REGARDING JURISDICTION

On April 25, 1995, the United States Court of Appeals for the Federal Circuit issued an order in which it granted ST's petition for a writ of mandamus in part and denied it in part. ST had petitioned for a writ of mandamus to compel the district court to try ST's claims for declaratory judgments of patent invalidity, unenforceability, and noninfringement to a jury. The court of appeals granted the petition as to ST's claims based on invalidity and noninfringement, but denied ST's petition as to its claim for a declaration of unenforceability due to fraud on the patent office. On July 24, 1995, cross-respondent International Rectifier filed a petition for a writ of certiorari in this Court.*

This Court has jurisdiction over this cross-petition under 28 U.S.C. § 1254(1). The court of appeals had jurisdiction over ST's petition for a writ of mandamus under 28 U.S.C. § 1651. The district court had jurisdiction over this case under 28 U.S.C. §§ 1331, 1338.

* The petition in No. 95-143 was received by cross-petitioner on July 25, 1995. This cross-petition is therefore timely under S. Ct. R. 12.3.

As discussed in ST's opposition to the petition for certiorari in No. 95-143, ST believes that the question presented in that petition is moot. On July 5, 1995, after the court of appeals had entered the decision at issue in the petition and cross-petition, the district court dismissed this case without prejudice. Opp. App., No. 95-143, pp. 5a-7a. The dismissal was based upon the fact that the United States Patent and Trademark Office ("PTO") was engaged in reexaminations of the patents at issue in this case and had rejected each of the claims in those patents that are relevant to this case. Although, pursuant to the district court's dismissal order, the parties may move to reinstate the case following the PTO's reexamination proceedings, there is presently no case pending between the parties in the district court and, therefore, there is no Article III jurisdiction in this Court. *See* Opp., No. 95-143, pp. 5-6.

Should this Court conclude, however, that there is jurisdiction over the petition in No. 95-143, jurisdiction would similarly exist over this cross-petition.

CONSTITUTIONAL PROVISIONS AND STATUTES INVOLVED

The relevant Constitutional provision, U.S. Const., amend. VII, and the relevant statute, 28 U.S.C. § 2201(a), are reproduced in the petition. Pet., No. 95-143, p. 3.

STATEMENT OF THE CASE

ST respectfully refers to the petition and opposition in No. 95-143 for a complete statement of the case. One of ST's declaratory judgment claims in the district court asserted that IR's patents were unenforceable because the patentees had committed fraud on the patent office by intentionally failing to disclose material prior art during the prosecution of their patent applications. ST demanded a trial by jury on that claim, as well as on its claims for declaratory judgments that IR's patents were invalid and

not infringed. Following the district court's order striking ST's jury demand as to all claims, ST sought a writ of mandamus from the Federal Circuit asserting that it was entitled to a jury trial on all of its declaratory judgment claims. Although the court of appeals agreed that ST was entitled to a jury trial on its invalidity and noninfringement claims—the rulings that are at issue in the petition in No. 95-143—it held that ST's claim for a declaratory judgment of unenforceability was not triable as of right to a jury. In reaching this conclusion, the court relied entirely upon prior Federal Circuit decisions that had held that the question of fraud on the patent office was "purely equitable" and therefore a question for the court. Pet. App., No. 95-143, p. 4.

REASONS FOR GRANTING THE CROSS-PETITION

The petition in No. 95-143 seeks this Court's review of two questions concerning the right to trial by jury in patent litigation: whether the right to jury trial attaches to an action seeking a declaratory judgment of patent invalidity, and whether the right attaches to an action seeking a declaratory judgment of noninfringement. This cross-petition presents a closely related question: whether the right to trial by jury attaches to an action seeking a declaratory judgment that a patent is unenforceable because the patentee committed a fraud on the patent office. If the Court were to grant the petition in No. 95-143, it should grant this cross-petition for three reasons: (1) the issues presented in the petition and the cross-petition are closely intertwined in patent law—a claim that a patent is invalid is often closely related to a claim that the patent is unenforceable; (2) the historical inquiry required under the Seventh Amendment will simultaneously resolve the issues presented in both the petition and the cross-petition; and (3) the Federal Circuit's decision that an action seeking a declaratory judgment of unenforceability presents only equitable issues, not triable to a jury, is incorrect.

1. Under the patent laws, the factual determinations necessary to resolve claims of invalidity and unenforceability will frequently overlap. A party may seek a declaratory judgment that a patent is invalid because the claimed invention or process was not patentable under 35 U.S.C. §§ 100-104. In general, those grounds are that the claimed invention either was not new, 35 U.S.C. § 102, or was obvious "to a person having ordinary skill in the art to which the subject matter pertains," 35 U.S.C. § 103.

The claim that a patent is unenforceable because the patentee committed "fraud upon the patent office" (also known as "inequitable conduct") is a claim that arises out of the process of applying for patents. The PTO requires that applicants for patents submit to it all information "which is material to the examination of the application. Such information is material where there is a substantial likelihood that a reasonable examiner would consider it important in deciding whether to allow the application to issue as a patent." 37 C.F.R. § 1.56(a). To protect the integrity of the patent process and to encourage full disclosure by patent applicants, the courts have developed a doctrine under which, if it can be proven that a patentee intentionally concealed information important to whether the patent should have been issued, a court will enter a judgment barring the patentee from enforcing that patent.

The Federal Circuit has described the elements of a "fraud on the patent office" or "inequitable conduct" claim as follows:

> The doctrine of inequitable conduct requires a trial court to undertake a two-step analysis. The trial court must discern whether the withheld references satisfy a threshold level of materiality. The court must also determine whether the applicant's

> conduct satisfies a threshold showing of intent to mislead.

Halliburton Co. v. Schlumberger Tech. Corp., 925 F.2d 1435, 1439 (Fed. Cir. 1991); *see also Kingsdown Medical Consultants v. Hollister, Inc.*, 863 F.2d 867, 872 (Fed. Cir. 1988) ("Inequitable conduct resides in failure to disclose material information, or submission of false material information, with an intent to deceive, and those two elements, materiality and intent, must be proven by clear and convincing evidence."), *cert. denied*, 490 U.S. 1067 (1989).

Thus, a claim seeking a declaratory judgment that a patent is unenforceable due to inequitable conduct asserts that the patentee intentionally failed to disclose material information to the PTO. Because the only information that is material is information that bears on the question of validity, claims for declarations of unenforceability and invalidity are necessarily intertwined. Although, to prevail on a claim of inequitable conduct, a party need not demonstrate that the patent actually would not have issued had the withheld information been disclosed to the PTO (*i.e.*, that the patent is invalid), *see, e.g., Molins PLC v. Textron, Inc.*, 48 F.3d 1172, 1179 (Fed. Cir. 1995), claims of invalidity and unenforceability nevertheless generally rest on the same underlying facts. For example, in *Therma-Tru Corp. v. Peachtree Doors Inc.*, 44 F.3d 988 (Fed. Cir. 1995), the Federal Circuit recognized that, under *Beacon Theatres, Inc. v. Westover*, 359 U.S. 500, 510-11 (1959), factual issues common to equitable claims and legal claims could not be tried to the bench and therefore instructed the district court to defer to the jury's findings on invalidity when considering related unenforceability claims.

2. The overlap between claims of invalidity and unenforceability in modern-day patent cases has its counter-

part in the procedural mechanisms available to resolve such claims under the English common law at the time of the adoption of the Seventh Amendment. As a result, the historical inquiry required under the Seventh Amendment to resolve the question presented by the petition in No. 95-143 is substantially the same as the historical inquiry required to resolve the question here, and a ruling on the petition would likely resolve this cross-petition as well.

The Seventh Amendment standard is well settled. The Seventh Amendment provides that "in suits at common law . . . the right of trial by jury shall be preserved." The fundamental inquiry is whether the suit, at common law, would have been tried to a jury. *Curtis v. Loether*, 415 U.S. 189, 193 (1974) ("the thrust of the Amendment was to preserve the right to jury trial as it existed in 1791").[1]

Here, the petition in No. 95-143 requires an inquiry into the action or actions available to a private party who sought to invalidate a patent in the English courts in 1791. The cross-petition requires an inquiry into the action or actions available in 1791 to a private party who sought relief in the English courts for fraud in the procurement of the patent. If this Court were to grant the petition, it should grant the cross-petition as well to permit both questions to be addressed and resolved in a single inquiry.

3. The Federal Circuit's decision that no jury trial right attached to an action seeking a declaratory judgment

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[1] The two-part *Tull* test—which inquires into the nature of the right and the remedy—is useful where the court is considering a new action (usually statutory) that did not exist in 1791. *Compare Tull v. United States*, 481 U.S. 412, 417 (1987); *Chauffeurs, Teamsters & Helpers Local No. 391 v. Terry*, 494 U.S. 558, 565 (1990). Where the action did exist at common law, and where there was a right to trial by jury in such an action in 1791, there is no need to deconstruct the action in the manner suggested by *Tull*.

that a patent was unenforceable due to inequitable conduct is clearly wrong. The court of appeals based its ruling on its own prior decisions holding that " 'inequitable conduct' is derived from the doctrine of unclean hands and is purely equitable in nature" and that therefore there was no right to trial by jury in an action seeking a declaratory judgment of patent unenforceability. *Gardco Mfg., Inc. v. Herst Lighting Co.*, 820 F.2d 1209, 1212 (Fed. Cir. 1987); *see also Paragon Podiatry Laboratory v. KLM Labs.*, 984 F.2d 1182, 1190 (Fed. Cir. 1993). Neither in those prior decisions nor in the decision below did the Federal Circuit conduct the historical analysis required by the Seventh Amendment.

That historical analysis yields an obvious and appropriate historical antecedent to an action for a declaratory judgment of unenforceability: an action for a writ of *scire facias*. At common law, a private party could bring an action for a writ of *scire facias* to assert that a patentee had committed a fraud upon the king and that the patent should not have issued. *See Ex parte Wood*, 22 U.S. (9 Wheat.) 603, 609 (1824) (Story, J.) (*scire facias* issued at common law "to repeal patents which have been obtained surreptitiously, or upon false suggestions"). Although a *scire facias* action was initiated in the Court of Chancery, the case was tried to a jury in a common law court. In fact, the Federal Circuit in *In re Lockwood*, 50 F.3d 966 (Fed. Cir.), *cert. granted*, 115 S. Ct. 2274 (1995), noted that the writ of *scire facias* would be the appropriate historical antecedent of an action for declaratory judgment based upon claims of inequitable conduct: "The contemporary analog of the writ [of *scire facias*] is thus an action for a declaration of unenforceability . . . ." 50 F.3d at 974 n.9. The Federal Circuit's failure to apply that insight in this case is inexplicable. *See* Pet. App., No. 95-143, p. 4.

In 18th-Century England, a party seeking to have a patent declared invalid or unenforceable would have

brought an action on a writ of *scire facias.* As this Court explained in *United States v. American Bell Telephone Co.*, 128 U.S. 315 (1888):

> Charters and patents authenticating grants of personal privileges were in the earlier days of the English government made by the crown. They were supposed to emanate directly from the king, and . . . the power of revoking them . . . was in the king, and was exercised by him as a personal privilege. This mode of revoking patents, however, seems to have fallen into disuse; and the same end was attained by the issue of writs of *scire facias*, in the name of the king, to show cause why the patents should not be repealed or revoked.

Id. at 360.

In the *Lockwood* case, the Federal Circuit noted the potential applicability of *scire facias*, but ultimately chose not to apply that historical analog because the court believed that the writ was available only to the king, and not to private parties. *See* 50 F.3d at 974 n.9. This belief, as Judge Nies properly noted in dissent from the denial of rehearing *in banc* in *Lockwood*, is unfounded. *See Lockwood*, 50 F.3d at 984 (Nies, J., dissenting).

Although a *scire facias* proceeding was brought in the name of the king, it was a remedy available as a matter of right to his subjects. The Court of the Queen's Bench held in *Brewster v. Weld*, 6 Mod. 229, 87 Eng. Rep. 980 (Q.B. 1704), that "if letters patents be to the prejudice of another, he may have a *scire facias*, upon the inrolment thereof in Chancery, to have them repealed, as well as the Queen may."[2] Blackstone further explained:

> [*Scire facias*] may be brought either on the part of the king in order to resume the thing granted; or, if

[2] *See also Underhill v. Devereux*, 2 Wms. Saund. 72, 85 Eng. Rep. 733 (K.B. 1671) (editor's notes) (noting that "the person prejudiced by the patent may, upon the enrollment of it in Chancery, have a *scire facias* to repeal it as well as the King").

> the grant be injurious to a subject, the king is *bound* of right to permit him (upon his petition) to use his royal name for repealing the patent in a *scire facias.*

3 William Blackstone, *Commentaries on the Law of England* *261 (emphasis added).[3] A leading commentator on patent law elaborates:

> A void or illegal patent for an invention, is in law prejudicial to every one of her Majesty's subjects, for it commands them to abstain from the use of the art or invention comprised in it. For this reason every person is presumed to have such an interest in a patent for an invention, that if he alleges that it is illegal or void, he is entitled as of right to a scire facias in the name of the Queen, in order to repeal it.

William M. Hindmarch, *A Treatise on the Law Relative to Patent Privileges for the Sole Use of Inventions* 385 (1847).[4]

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[3] *See also Sir Oliver Butler's Case*, 2 Ventr. 344, 86 Eng. Rep. 477 (1679) (holding that "where a patent is granted to the prejudice of the subject, the King of right is to permit him, upon his petition, to use his name for the repeal of it in *scire facias* at the King's suit").

[4] Some late 19th Century United States cases do hold that only the government can seek a declaration of patent invalidity. *See United States v. American Bell Telephone Co.*, 128 U.S. 315 (1888); *Mowry v. Whitney*, 81 U.S. (14 Wall.) 434 (1871). But, read carefully, those cases indicate that, in the English courts, a private party could initiate a suit to have a patent invalidated. That suit, as the cases acknowledge, was brought in the name of the king, but the king was required to lend his name to any person injured by the issuance of the patent. *See Mowry*, 81 U.S. at 440 ("[W]hen a patent is granted to the prejudice of the subject, the king of right is to permit him upon his petition to use his name for the repeal of it, in *scire facias* at the king's suit."); *American Bell Telephone*, 128 U.S. at 360 (noting that *scire facias* could be brought "in the name of the king").

The reason that *Mowry* and *American Bell Telephone* denied a private action for *scire facias* can be traced to the 1836 revision

In England in 1791, *scire facias* proceedings, although brought in chancery, were tried in a common law court. Blackstone explained that the English Court of Chancery consisted of

> two distinct tribunals: the one ordinary, being a court of common law; the other extra-ordinary, being a court of equity.
>
> The ordinary legal court is much more ancient than the court of equity. Its jurisdiction is to hold plea upon a *scire facias* to repeal and cancel the king's letters patent . . . .

3 Blackstone, *Commentaries* *47. "These legal proceedings [to invalidate a patent] were in the office called the 'Petty Bag,' the office of the court of chancery, in which all common-law proceedings of the court were carried on . . . ." *Attorney General ex rel. Hecker v. Rumford Chemical Works*, 32 F. 608, 618 (C.C.D.R.I. 1876). Although it was located within the Court of Chancery, the Petty Bag Office was a common law court, not a court of equity, and *scire facias* was a legal, not an equitable, action.

Because a *scire facias* brought in chancery was an action at law, the parties were entitled to have issues of fact tried by a jury. The anomaly that *scire facias* actions were initiated in the common law tribunal in the Court of Chancery, rather than in the King's Bench, in no way altered the parties' fundamental right to a jury trial. "On principle, the issues presented in a proceeding by *scire facias* must be triable in the same manner as like issues

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of the U.S. patent laws. Before that time, the patent laws provided that a private individual could seek a ruling of invalidity through *scire facias*. *See American Bell Telephone*, 128 U.S. at 371 ("Prior to the year 1836, from the earliest enactments of patent law, certain provisions had been incorporated in that law authorizing a *scire facias* . . . instituted by a private individual . . ."). The 1836 revision eliminated this private right of action. *See American Bell Telephone*, 128 U.S. at 371 ("The statute of 1836 repealed the provision for a *scire facias*.").

presented in other proceedings at law, and that the parties are entitled to a trial of issues of fact before a jury, if either so demands, is generally conceded." 24 Ruling Case Law, *Scire Facias*, § 22 (Eds. William M. McKinney & Burdett A. Rich, 1919); see also *Rumford Chemical Works*, 32 F. at 619 ("The only means which the law [of England] provides for the repealing of letters patent (for inventions) is by action of *scire facias* at the suit of the queen, and, as we have seen, this was a *quasi* common-law proceeding, with the right of trial by jury.") (citations omitted).

In fact, this Court has explicitly recognized that a *scire facias* sought on the basis that the patentee had committed a fraud upon the king was tried to a jury. "If a patent has been fraudulently obtained, or upon false suggestions, it may be repealed within three years, if a jury, upon a trial, shall be satisfied of the fact." *Ex parte Wood*, 22 U.S. (9 Wheat.) 603, 613-14 (1824) (Story, J.); *see also Mowry v. Whitney*, 81 U.S. (14 Wall.) 434, 439, 441 (1871). *Compare Lockwood*, 50 F.3d at 974 n.9.

However, the Chancellor, whose normal jurisdiction was in equity, was without power to summon a jury. Thus, if an issue of fact arose in a *scire facias* action, the Chancellor sent the case to the Court of the King's Bench, where the issue was then tried to a jury:

> [I]f any fact be disputed between the parties, the chancellor cannot try it, having no power to summon a jury; but must deliver the record *propria manu* into the court of king's bench, where it shall be tried by the country, and judgment shall be there given thereon.

3 Blackstone, *Commentaries* *48. In this manner, the parties' right to a jury trial was preserved.[5] *See also Rum-*

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[5] In *United States v. American Bell Telephone Co.*, 128 U.S. 315, 361-62 (1888), this Court cited *King v. Butler*, 3 Lev. 220, 83 Eng.

ford Chemical Works, 32 F. at 619 (a *scire facias* action "was a *quasi* common-law proceeding, with the right of trial by jury"); Neil Davenport, *The United Kingdom Patent System: A Brief History* 78 (1979) ("the validity of the patent was then tried, usually with a jury in the Court of the King's (or Queen's) Bench").

At the time of the Seventh Amendment, as a prominent early 19th-Century commentator noted, it was established in England that "the Court of Chancery never decides upon the validity of a patent, . . . if any question arises upon the validity of the patent, the novelty of the invention, or the sufficiency of the specification, it is uniformly referred to a court of law." John Davies, *A Collection of the Most Important Cases Respecting Patents of Invention and the Rights of Patentees* ix (1816). In the words of Justice Story, "[the procedure] to try the validity of the patent . . . is in the nature of a *scire facias* at the common law, to repeal patents, and the issues of fact, if any, are to be tried, not by the court, but by a jury . . . ." Joseph Story, *On the Patent Laws*, 16 U.S. (3 Wheat.) app. 13,

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Rep. 659 (H.L. 1685), a case in which the House of Lords declared that a *scire facias* in Chancery was the proper action for repealing a patent. After reviewing the *Butler* opinion, this Court concluded that "[t]he whole text of the answers of the judges in this case seems to imply that a jury was not necessary" in a *scire facias* action. *Bell Telephone*, 128 U.S. at 362. This was only true, however, because Butler's case presented no issues of fact. The House of Lords held that, since "the matter in the *sci. fa.* appear[ed] sufficient, and not denied by any plea of the defendant, but confessed by his demurrer, a judgment peremptory in Chancery ought to be given." *Butler*, 3 Lev. at 223, 83 Eng. Rep. at 661. Had the defendant properly asserted the validity of the patent, the issue would have been tried to a jury at King's Bench. *See* 2 Francis Stoughton Sullivan, *Lectures on the Constitution and Laws of England* 175 (1805) ("When, therefore, the cause was heard upon a *demurrer*, that is, the facts admitted of both sides, and only the law in dispute, [the Chancellor] gave judgment; but if they came to issue on a fact, he must carry the record over to the King's Bench, who summoned the jury, and gave judgment on the verdict.").

28 (1818); *see also Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 1013 (Fed. Cir. 1995) (*in banc*) (Newman, J., dissenting) ("These relationships were well established by the date of the Seventh Amendment. Issues of patent infringement and validity were tried only to a jury . . . .").

CONCLUSION

For the foregoing reasons, should the petition in No. 95-143 be granted, this cross-petition should be granted as well.

Respectfully submitted,

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September 25, 1995

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QUESTION PRESENTED

When a party seeks only an equitable injunction barring further acts of patent infringement, does the opposing party gain a Seventh Amendment right to a jury trial by re-casting its affirmative defense of "inequitable conduct" as a counterclaim for declaratory relief?

LIST OF AFFILIATES

Pursuant to Supreme Court Rule 29.1, there are no parent companies or non-wholly owned subsidiaries of the cross-respondent, International Rectifier Corporation.

No. 95-321

In The

Supreme Court of the United States

October Term, 1995

SGS-THOMSON MICROELECTRONICS, INC.,

Cross-Petitioner,

v.

INTERNATIONAL RECTIFIER CORPORATION,

Cross-Respondent.

Cross-Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

BRIEF IN OPPOSITION

Respondent International Rectifier Corporation ("IR") respectfully submits that SGS-Thomson Microelectronics, Inc.'s ("ST's") cross-petition for a writ of certiorari should be denied. None of the traditional criteria for granting certiorari are present. Rather, the Federal Circuit's ruling is merely another link in a long chain of decisions which have reached the same result on the same facts. Review of that ruling would add nothing to the Court's review and consideration of the question presented by IR's Petition in No. 95-143.

DECISIONS BELOW

The relevant opinions of the Federal Circuit Court of Appeals (Pet. App., pp. 1-4; Opp. App., pp. 1a-3a) have recently been published. *In re SGS-Thomson Microelectronics, Inc.*, 35 USPQ2d 1639 (1995) (denial of IR's suggestion for rehearing *en banc*); *In re SGS-Thomson Microelectronics, Inc.*, 35 USPQ2d 1572 (1995) (grant in part and denial in part of ST's petition for writ of mandamus). The Federal Circuit's denial of suggestion for rehearing *en banc* is a precedential decision; that court's decision on ST's petition for writ of mandamus is not.

STATEMENT OF THE CASE

In its statement of the case, and elsewhere in its cross-petition, ST refers to its subject defense and declaratory relief claim as asserting "fraud on the patent office." (*E.g.*, Cross-Pet., pp. i, 2-5.) Such a description is disfavored; the correct label is, and has been for at least ten years, "inequitable conduct."[1] ST cannot disguise the "equitable" nature of its defense and counterclaim by mislabeling them as "fraud."

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[1] *See, e.g., Korody-Coyler Corp. v. General Motors Corp.*, 760 F.2d 1293, 1294 n.1 (Fed. Cir. 1985) (" 'inequitable conduct' more properly describes what has been called 'fraud on the Patent and Trademark Office' "); *In re Harita*, 847 F.2d 801, 807 (Fed.Cir. 1988) ("What was once simply called 'Fraud on the patent office,' . . . now bears the name 'inequitable conduct' "); *Tennant Co. v. Hako Minuteman, Inc.*, 651 F. Supp. 945, 957 (1986) ("given the differences between conduct which makes a patent unenforceable and the acts which give rise to a common law action for fraud, the Federal Circuit now prefers the characterization 'inequitable conduct' ").

REASONS FOR DENYING THE CROSS-PETITION

I. THE CROSS-PETITION IS NOT "CERTWORTHY."[2]

The cross-petition raises no conflict among the federal courts, no conflict among the state courts on a federal question, no conflict with the decisions of this Court, and no important question of federal law which needs to be settled by this Court. (*See* Sup. Ct. Rule 10.1(a)-(c).) ST does not suggest otherwise. The absence of any "special and important reason" for granting certiorari should be reason enough to deny it. (*Id.*, Rule 10.1.)

II. THE FEDERAL CIRCUIT'S RULING IS NOT NOVEL.

ST argues that its cross-petition should be treated the same as IR's Petition because the legal issues are supposedly related and the Federal Circuit supposedly erred to the extent of its ruling against ST. (Cross-Pet., p. 4.) Neither argument has merit. The relationship between the jury trial issues in IR's Petition and ST's Cross-Petition is superficial at best. While both petitions arise from customary patent affirmative defenses that have been recast as redundant declaratory relief claims, the authority for the Federal Circuit's rulings could not be more different.

In stark contrast to the Federal Circuit's ruling on the issue in IR's Petition (*see* Pet., pp. 9-20), its decision on the issue in ST's Cross-Petition follows a long and unbroken line of cases holding that *no* jury trial right attaches to inequitable conduct. *See, e.g., General Electro Music Corp. v. Samick*

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[2] Justice Harlan, *Manning the Dikes*, 13 Record of N.Y.C. Bar Ass'n 541, 549 (1958), *quoted in* Stern, Gressman, Shapiro & Geller, *Supreme Court Practice* at 166 & n.7 (7th ed. 1993).

Music Corp., 19 F.3d 1405, 1408 (Fed. Cir. 1994) (citing *Gardco Mfg., Inc. v. Herst Lighting Co.*, 820 F.2d 1209, 1212 (Fed. Cir. 1987)) ("[t]he disputed issues of fact underlying the issue of inequitable conduct are not jury questions, the issue being entirely equitable in nature"); *Paragon Podiatry Laboratory Inc. v. KLM Laboratories Inc.*, 984 F.2d 1182, 1190 (Fed. Cir. 1993) ("The defense of inequitable conduct in a patent suit, being entirely equitable in nature, is not an issue for a jury to decide"); *Wahpeton Canvas Company, Inc. v. Frontier, Inc.*, 870 F.2d 1546, 1548 n.1 (Fed. Cir. 1989) ("inequitable conduct is an equitable issue triable by the judge"); *Solarex Corp. v. Arco Solar, Inc.*, 870 F.2d 642, 644 n.2 (Fed. Cir. 1989) ("inequitable conduct is equitable, not legal, in nature"); *Gardco*, 820 F.2d at 1213 (affirming district court's decision to try inequitable conduct defense separately in a bench trial in advance of jury trial on validity and infringement defenses). The roots of the inequitable conduct defense have been traced back to the distinctly equitable doctrine of "unclean hands" and a decision of this Court. *Gardco*, 820 F.2d at 1212 (citing *Precision Instruments Mfg. Co. v. Automotive Maintenance. Mach. Co.*, 324 U.S. 806 (1945)).

ST would have the Court overrule all these decisions and others. Yet ST proffers ***no controlling precedent*** that is inconsistent with these decisions or that supports ST's position. Rather, ST engages in the " 'abstruse historical' search" that this Court has cautioned against in situations where, as here, the historically equitable foundation for the claim (inequitable conduct) is so well-established (the equitable doctrine of unclean hands). *See Tull v. United States*, 481 U.S. 412, 421 (1987) (quoting *Ross v. Bernhard*, 396 U.S. 531, 538 n.10 (1970)).

ST then compounds its error by committing the same fundamental error as the Federal Circuit in *In re Lockwood*, 50 F.3d 966 (Fed. Cir.), *vacated sub. nom, American Airlines,*

Inc. v. Lockwood, ___ U.S. ___ (1995): an utter failure to consider the second, and more important, part of this Court's Seventh Amendment test under which the court must " 'examine the remedy sought and determine whether it is legal or equitable in nature.' " *Granfinanciera, S.A. v. Nordberg*, 429 U.S. 33, 42 (1989) (quoting *Tull*, 481 U.S. at 417-18).

No party to this case is seeking monetary relief or the return of property, the only two forms of relief that this Court has recognized as being legal in nature (Pet., pp. 16-17). IR seeks injunctive relief, which lies at the very core of equitable remedies (*id.*, p. 11), and ST seeks a declaration of rights (specifically a declaration that IR's patents are unenforceable because of inequitable conduct), a form of relief traditionally recognized by this Court as being equitable in nature (*id.*, pp. 18-19; *see also* pp. 3-4, *supra*), and which, in any event, does not alter the basic character of the action or the parties' jury trial rights, if any, in the underlying controversy, *Simler v. Conner*, 372 U.S. 221, 223 (1963).

CONCLUSION

ST's cross-petition should be denied.

September 25, 1995

Respectfully submitted,

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On Cross-Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

CROSS-PETITIONER'S REPLY TO INTERNATIONAL RECTIFIER'S BRIEF IN OPPOSITION TO CROSS-PETITION

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CROSS-PETITIONER'S REPLY TO INTERNATIONAL RECTIFIER'S BRIEF IN OPPOSITION TO CROSS-PETITION

In its Cross-Petition, SGS-Thomson Microelectronics Inc. ("ST") argued that, should the Court grant certiorari on International Rectifier Corporation's ("IR's") Petition (No. 95-143) to consider the Seventh Amendment right to trial by jury in cases in which a party is seeking declaratory judgments of patent invalidity and

[1] The Rule 29.1 Statement appears at p. ii of the Cross-Petition.

noninfringement, the Court also should consider the issue (raised by the Cross-Petition) of the Seventh Amendment right to trial by jury where a party seeks a declaratory judgment that a patent is unenforceable due to inequitable conduct by the patentee.

IR's Opposition to the Cross-Petition presents no reason to deny the Cross-Petition should the Petition be granted. IR's Opposition completely elides the fact that ST's Cross-Petition is conditional, and therefore can be granted only if IR's Petition is granted. IR also simply ignores ST's principal argument that, if the Petition is granted, the Cross-Petition should be granted because the issues in the Petition and Cross-Petition are inextricably intertwined as a matter of substantive patent law and practice and as a matter of historical inquiry under the Seventh Amendment. Moreover, the two arguments that IR does make—(1) that the Federal Circuit (but no other appellate court) in several cases has stated that there is no jury trial right in actions seeking declarations of patent unenforceability due to inequitable conduct and (2) that the remedy ST seeks is not equitable—wholly fail to justify denying the conditional Cross-Petition.

1. The Cross-Petition demonstrated that the issues of invalidity and unenforceability are intertwined as a matter of patent law. A patent is unenforceable due to inequitable conduct where the patent applicant intentionally withheld from the patent office information material to whether the patent should have been granted—such as material prior art references. This question is of course related to the question whether the patent is valid—*i.e.*, whether it should have issued under the patent laws. *See* Cross-Petition, pp. 5-6. Similarly, the historical inquiries are related. Under the Seventh Amendment, the first inquiry is into historical practice, and the 18th-Century English patent practices governing invalidity and unenforceability actions were the same. *Id.*, pp. 6-7.

Thus, IR's contention that the Cross-Petition is not "certworthy" under this Court's rules is, in addition to being flatly wrong, simply not responsive: ST contends that the Petition in No. 95-143 should not be granted, but *if it were*, this Court should also grant the Cross-Petition because it raises a related important question (and because the Federal Circuit's decision on the issue was so clearly error). In all events, the Cross-Petition independently raises an "important question of federal law which should . . . be settled by this Court." S. Ct. R. 10.1(c). The scope of the right to trial by jury in patent cases has recently been the subject of three significant decisions of the Federal Circuit (two *in banc*). *See In re Lockwood*, 50 F.3d 966 (Fed. Cir.), *cert. granted*, 115 S. Ct. 2274, *vacated*, —— S. Ct. —— (U.S. Sept. 1, 1995) (right to jury trial in action seeking declaratory judgment of patent invalidity); *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir.) (in banc), *cert. granted*, ——S. Ct. —— (U.S. Sept. 27, 1995) (right to jury trial on issue of claim construction present in damages action); *Hilton Davis Chemical Co v. Warner-Jenkinson Co.*, 62 F.3d 1512 (Fed. Cir. 1995) (in banc) (right to jury trial on issue of prosecution history estoppel). This Court has granted *certiorari* in one case presenting Seventh Amendment issues nearly identical to those presented by the Cross-Petition (*Lockwood*) and in one case presenting somewhat analogous issues (*Markman*[2]).

2. IR's contention that the Cross-Petition should be denied because the Federal Circuit has never questioned its prior holdings that found no jury trial right in actions

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[2] The Question Presented in *Markman* is: "In patent infringement actions for damages, is there a right to jury trial under Seventh Amendment of genuine factual disputes about meaning of patent?" Thus, *Markman* does not directly address the question presented in the Petition or Cross-Petition: whether there is a right to jury trial on issues of invalidity and unenforceability where the party asserting invalidity or unenforceability proceeds by way of a declaratory judgment action.

presenting claims of unenforceability is both insubstantial and incorrect. IR is correct that it has been the consistent holding of the Federal Circuit since 1987 that parties are not entitled to a trial by jury on issues of inequitable conduct. *See General Electro Music Corp. v. Samick Music Corp.*, 19 F.3d 1405, 1408 (Fed. Cir. 1994); *Paragon Podiatry Lab. Inc. v. KLM Labs. Inc.*, 984 F.2d 1182, 1190 (Fed. Cir. 1993); *Wahpeton Canvas Co. v. Frontier, Inc.*, 870 F.2d 1546, 1548 n.1 (Fed. Cir. 1989); *Solarex Corp. v. Arco Solar Inc.*, 870 F.2d 642, 644 n.2 (Fed. Cir. 1989); *Gardco Mfg., Inc. v. Herst-Lighting Co.*, 820 F.2d 1209, 1212 (Fed. Cir. 1987). But in none of these decisions (hardly a "long" line of cases, Opp., p. 3) did the Federal Circuit analyze, as the Seventh Amendment requires, the historical antecedent for a claim of inequitable conduct, other than to assert that inequitable conduct was derived from the doctrine of unclean hands, which the Federal Circuit extrapolated into its rule that inequitable conduct is a "solely equitable" issue.

Gardco was the first case in the line, and that court's discussion of the Seventh Amendment question was cursory in the extreme. In fact, in *Gardco,* the Federal Circuit simply cited *Precision Instrument Manuf. Co. v. Automotive Maintenance Machinery Co.*, 324 U.S. 806 (1945), for the proposition that " 'inequitable conduct' is derived from unclean hands and is purely equitable in nature." *Gardco,* 820 F.2d at 1212. But *Precision Instrument* stands for no such proposition: that case held only that the inequitable conduct of a patentee is a form of unclean hands which can give a court of equity the power to *deny* a patentee's request for an injunction. *See* 324 U.S. at 814-15, 819. In *Precision Instruments,* the party asserting inequitable conduct had not asserted that claim through a declaratory judgment action, and there was no consideration of the right to jury trial. Moreover, in *Gardco,* the party seeking the jury trial did not assert (as ST does here) that there was an independent jury

trial right in an action for a declaration of unenforceability, and the issue therefore was not squarely before the Federal Circuit in that case. *See* 820 F.2d at 1213 ("Peerless does not challenge Gardo's statement that the defense of inequitable conduct is purely equitable"). Instead, the plaintiff in *Gardco* had asserted that a jury trial right attached to its infringement claim and that it therefore had a right to a jury trial on unenforceability. The Federal Circuit stated that the trial court could, without invading the jury's province, rule on the unenforceability question independently. Despite the extremely limited scope of *Gardco*, however, no Federal Circuit case since has reexamined the question.

Further, IR's statement that "ST offers no controlling precedent that is inconsistent with these decisions" (Opp., p. 4), is a carefully worded obfuscation, made possible only because this Court has recently vacated the Federal Circuit's decision in *Lockwood*. For the Federal Circuit itself in that case, when it discussed the clear (not "abstruse," Opp., p. 4) historical antecedent for declaratory actions in patent cases—the English writ of *scire facias*—stated that "[t]he contemporary analog of the writ [of *scire facias*] is thus an action for a declaration of unenforceability." *Lockwood*, 50 F.3d at 974 n.9. As explained in the Cross-Petition (pp. 8-14), the practice in England at the time of the adoption of the Seventh Amendment was clear: where there were disputed issues of fact, a party seeking to have a patent declared invalid or unenforceable tried its case to a jury.

3. IR's final argument, that analysis of the "remedy sought" is all that is required and that such an analysis demonstrates that there can be no jury trial right in actions for declaratory judgments of unenforceability, similarly misses the clear import of the historical evidence ST marshalled in the Cross-Petition. IR argues that the only cases in which this Court has previously recognized a Seventh Amendment right to a trial by jury are cases

in which the remedy sought was "monetary relief or the return of property" and that, therefore, there can be no jury trial right here. That is wrong for (at least) three reasons.

First, a patent is a property right—albeit an intangible property right—and an action for a declaratory judgment of unenforceability seeks to "eject" the patentee from that right. *Compare Pernell v. Southall Realty*, 416 U.S. 363, 370 (1974) (action for ejectment is "at law triable to a jury").

Second, this Court has recognized jury trial rights where the remedy sought has been other than monetary damages or the return of property. In *Tull v. United States*, 481 U.S. 412 (1987), this Court recognized a right to trial by jury on questions of liability under the Clean Water Act (*id.* at 422) where the remedies sought were civil penalties and an injunction, and despite the fact that the Court found that Congress did (and could permissibly) take away from the jury the right to determine the *amount* of the civil penalty (*id.* at 425-27).

Third, neither this Court nor any other court has ever held that a Seventh Amendment right to a jury trial can exist *only* where the relief sought is damages or the return of property. Thus, even if a declaration of patent unenforceability is a *sui generis* remedy, the historical inquiry based on the writ of *scire facias* so clearly demonstrates that in 1791 there was a right to trial by jury where a person sought to have a patent declared unenforceable that the Seventh Amendment—which by its literal terms "preserves" the right to trial by jury "at common law"—right must be recognized. The statements upon which IR relies that downplay the importance of the historical inquiry (Opp., p. 4) are not applicable here, where the historical antecedent is so clear. *See* Cross-Petition, pp. 7-9 & n.1.

In this regard, IR commits its familiar error of focusing on the nature of the relief *it* seeks (Opp., p. 5) instead of on the nature of the relief sought by ST's declar-

atory action. Although IR has abandoned its earlier frivolous argument that declaratory judgment actions can only be equitable actions (*compare* Pet., No. 95-143, p. 19, *with Reply*, No. 95-143, p. 5 *and* Opp., No. 95-321, p. 5), IR now attempts to assert that under *Simler v. Conner*, 372 U.S. 221, 223 (1963), the essential controversy between the parties here is not altered because ST is pursuing a declaratory action (as opposed to asserting an affirmative defense) based upon IR's inequitable conduct. But that argument is squarely foreclosed by *Cardinal Chem. Co. v. Morton Int'l, Inc.*, 113 S. Ct. 1967, 1975 (1993): "A party seeking a declaratory judgment of invalidity presents a claim *independent* of the patentee's charge of infringement" (emphasis added).

CONCLUSION

For the foregoing reasons, should this Court grant certiorari in No. 95-143, it should grant this Cross-Petition as well.

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